

REMARKS

Applicant has carefully studied the Office Action of September 30, 2004, and offers the following remarks to accompany the above amendments.

Claims 3, 4, 9, 10, 11, 12, 19, and 21 were amended to make the claim language consistent such that there is no ambiguity as to whether a claim element is referring to a previously introduced claim element. The scope of the claims has not changed, but the language is now consistent.

Claims 1, 9, 10, 11, and 12 are amended to include the subject matter of original claim 2, and claim 2 is canceled as redundant in light thereof. Claim 19 is amended to include the subject matter of claim 20. Claim 20 is canceled as redundant in light thereof.

Before addressing the rejections based on the references, Applicant provides a brief summary of the present invention so that the remarks relating to the references are considered in the proper context. The present invention is directed to a system of distributed registries that identify service providers and the addresses thereof so that a user may access a desired service. To this end, the present invention provides a series of distributed registries. A user sends a query to one of the registries of service providers with an indication of what sort of attributes are required for a desired service. The registry then searches its entries to determine if a service provider matches the query. If the answer is yes, the registry does have such an entry, then the registry sends identifying information (typically an address) to the user, such that the user may access the service provider and receive the desired service.

If, however, the answer is no, the registry does not have an entry that can satisfy the query, then the registry relies on the other registries within the system of distributed registries. To this end, the registries are arranged hierarchically, and the query is passed up the hierarchy in hopes that somewhere else in the hierarchy there is an entry within the system of registries which can satisfy the query.

Claims 1-4, 6-12, 15-17, 19, and 22 were rejected under 35 U.S.C. § 102(e) as being anticipated by Pettus. Applicant respectfully traverses. For the Patent Office to establish anticipation, the Patent Office must show where each and every claim element is located in the reference. Further, the elements of the reference must be arranged as claimed. MPEP § 2131.

Original claim 2, now amended claim 1, recited "if none of said plurality of service providers in said registry can provide said requested data network service having said required

attributes, selecting a remote directory service utility; and sending a propagated query to said remote directory service utility.” The claim language corresponds to the situation where the first registry does not have an appropriate entry and asks the other registries of the system of distributed registries if they have an entry that satisfies the query. Pettus does not show this claim element.

The Patent Office opines that Pettus discloses this element at column 15, lines 19-31 and column 16, lines 13-16. Applicant respectfully traverses this assertion. The cited passages talk about how a client coordinates with the communications directory service to access a remote service. That is, the cited passage describes what happens after the communications directory service identifies an object therein that satisfies the client’s query and provides the object to the client. As would be expected, the client establishes a communication link to the service provider and receives the service. However, contacting a remote service provider is not the same as “selecting a remote directory service utility” and “sending a propagated query to said remote directory service utility.” There is no teaching or suggestion in Pettus that the remote service is part of a distributed registry of service providers, or that the remote service can function as a directory service utility. To this extent, Pettus does not teach or suggest the recited claim element. Since Pettus does not teach or suggest the recited claim element, Pettus cannot anticipate the claim. Since Pettus does not anticipate the claim, the claim is allowable. Applicant requests withdrawal of the § 102(e) rejection of claim 1 and dependent claims 3, 4, and 6-8 at this time.

Claim 3 deserves special mention in that it recites “consulting a summary of services available at said remote directory service utility. . . .” Since Pettus does not teach a remote directory service utility being contacted, there can be no consultation of a summary of services available at said remote directory service utility as recited in the claim. The Patent Office points to Pettus, column 16, lines 30-39 to show the claim element. Applicant respectfully traverses this assertion. The cited passage discusses a request being sent to a remote service, not a directory service utility. As such, the cited passage does not teach the recited element.

Claim 4 also deserves special mention in that it recites “said remote directory service is hierarchically higher than a directory service utility performing said selecting.” The Patent Office opines that this element is taught at Pettus, column 10, lines 21-22. While Pettus discloses a hierarchical relationship in the communications directory service, this is not the same

thing as the recited hierarchical relationship between different directory service utilities as recited in the claim. That is, the communications directory services of Pettus that are located on different machines are not arranged in any sort of hierarchical relationship, rather, merely the contents of a given communications directory service are arranged hierarchically. These are not the same thing, and Pettus does not show the claim element.

Claims 9-12 have also been amended to include the subject matter of original claim 2, and are not anticipated for the reasons discussed above. Applicant requests withdrawal of the § 102(e) rejection of claims 9-12 at this time.

Claims 15-17 have been canceled, thereby mooted the rejection thereof.

Claim 19 has been amended to recite the subject matter of claim 20, which was admittedly not anticipated by Pettus. Applicant addresses the subject matter of claim 20 below in the rejection of claim 20.

Claim 22 recites "consulting a summary of services available at service providers registered with at least one remote directory service utility . . . sending a propagated query to said particular remote directory service utility. . . ." The Patent Office asserts that these elements are taught at Pettus, column 15, lines 19-31 and column 16, lines 13-16. As explained above, the remote service described in these passages is not a remote directory service utility, and the query is not propagated thereto as recited in the claim. To this extent, claim 22 recites elements not shown by Pettus, and the § 102(e) rejection is improper. Applicant requests withdrawal of the § 102(e) rejection of claim 22 at this time.

Claims 5 and 13 were rejected under 35 U.S.C. § 103 as being unpatentable over Pettus in view of Hemphill et al. (hereinafter "Hemphill"). Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim can be found in the combination of references. MPEP § 2143.03. Furthermore, before the Patent Office can combine references for an obviousness rejection, the Patent Office must do two things. First, the Patent Office must articulate a motivation to combine the references, and second, the Patent Office must support that motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). The Patent Office usually relies on *In re Fine* teachings that the motivation may come from many different types of sources. *In re Dembiczak* does not dispute the available range of sources, but, while acknowledging the

myriad sources allowed by *In re Fine*, instructs the Patent Office that the range of sources does not diminish the requirement for actual evidence. *In re Dembiczak* at 999.

Applicant initially notes that the Patent Office has not complied with the Federal Circuit's edicts in *Dembiczak*. Specifically, the Patent Office opines that it would be obvious to combine Pettus and Hemphill "to send queries from client to server when requesting data network service." However, this asserted motivation is devoid of any actual evidence. As such, the asserted motivation is improper. Since the asserted motivation is improper, the combination is improper, and the references individually do not establish *prima facie* obviousness. Since the references individually do not establish obviousness, claim 5 is allowable.

Even if the combination is proper, a point which Applicant does not concede, Hemphill does not cure the deficiencies of Pettus. That is, even in combination, Pettus and Hemphill do not teach the propagation of a query to a remote directory service utility as recited in claim 5.

Applicant has canceled claim 13, mooted the rejection thereof.

Claim 14 was rejected as being unpatentable over Pettus. Applicant has canceled claim 14, mooted the rejection thereof.

Claims 18 and 20 were rejected under 35 U.S.C. § 103 as being unpatentable over Pettus in view of Taylor. Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially notes that the motivation to combine Pettus and Taylor is not supported with the requisite actual evidence. Specifically, the Patent Office opines that the motivation to combine the references is "develop relationships between separate directory service utilities." This motivation is devoid of any evidence to support it. As such, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the references must be considered individually. Since the references must be considered individually, and the references individually admittedly do not establish obviousness, claims 18 and 20 are allowable.

Even if the combination is proper, a point which Applicant does not concede, the combination does not teach the recited claims. Specifically, the recited claims recite a parent-child relationship between directory service utilities. The Patent Office admits that Pettus does not teach this element, but opines that Taylor teaches parent-child relationships for nodes. Even if the references are combined, there is still no teaching that the directory services would be

arranged in a parent-child relationship. Specifically, Pettus already contemplates a relationship between the disparate communications directory services. Namely, they are all peers that share the same information (see Pettus, column 4, lines 14-15, 20-28). The Patent Office has to extract an isolated portion of Pettus in the combination to arrive at the claimed invention. This selective extraction of an isolated element is impermissible. The references must be considered as a whole. MPEP § 2141.02. Since the Patent Office has ignored this rule, the combination does not teach or suggest the claim element, and the combination does not establish obviousness.

Claim 21 was rejected under 35 U.S.C. § 103 as being unpatentable over Pettus in view of Aucsmith. Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially notes that the amendment to claim 19 necessitates the addition of Taylor to this rejection. In the interests of advancing prosecution, Applicant proceeds as if the Patent Office had made such a rejection. As noted above, the motivation to combine Pettus and Taylor is deficient. Furthermore, the motivation to combine Pettus and Aucsmith is deficient. The Patent Office asserts that the motivation is "to improve computer efficiency." However, there is no evidence to support this assertion. Specifically, there is no evidence to indicate that Pettus or Aucsmith is concerned with efficiency, or that the recited elements of Aucsmith improve the efficiency of Pettus. To this extent, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the references must be considered individually. Since the references must be considered individually, and the references individually admittedly do not establish obviousness, claim 21 is allowable.

Applicant further traverses the rejection because, as noted above, Pettus and Taylor do not teach or suggest the elements of the underlying independent claim. The addition of Aucsmith does not cure this deficiency. Since the combination does not establish obviousness, claim 21 is allowable for this reason as well.

Applicant requests reconsideration of the rejections in light of the amendments and remarks presented herein. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

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